



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Billington et al.

Art Unit : 3653

Serial No. : 09/543,164

Examiner : Jeffrey A. Shapiro

Filed : April 5, 2000

Title : MONEY ACCEPTANCE METHOD AND APPARATUS

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 CFR 1.193(b)(1), Applicant responds to the new points raised in the Examiner's Answer as follows.

Related Appeals and Interferences

At page 2, par. (2) of the Examiner's Answer, the Examiner states that applicant's Brief on Appeal does not contain a statement identifying the related appeals and interferences. That is incorrect. See page 1, par. (2) of the Brief on Appeal, which indicates that there are no related appeals or interferences.

Status of Claims and Issues

At page 2, par. (3), and page 3, par. (6) of the Examiner's Answer, the Examiner states that claims 25 and 27 also were rejected in the final Office action under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,085,888 (Tedesco et al.) and as unpatentable over U.S. Patent No. 6,055,521 (Ramsey et al.).

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR § 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

August 3, 2004

Date of Deposit

Signature

Paula T. Romeo

Paula T. Romeo

Typed or Printed Name of Person Signing Certificate

Applicant submits that claims 25 and 27 were not rejected in the final Office action as unpatentable over the Tedesco et al. and Ramsey et al. patents, at least not in a way that reasonably put the applicant on notice of those rejections.

According to the statements at page 5, par. 5 (lines 1-3) and page 6, par. 6 (lines 1-3) of the final Office action (August 28, 2003), claims 25 and 27 are *not* included in the list of claims rejected over the Tedesco et al. and Ramsey et al. patents.

During a teleconference with the Examiner on or about June 21, 2004, the Examiner pointed to the passing references to those claims at page 6, line 1 and at page 7, line 4.

Applicant submits that the final action provided insufficient notice to the applicant that the Examiner was rejecting claims 25 and 27 as unpatentable over the Tedesco et al. and Ramsey et al. patents. Nevertheless, in the following paragraphs, applicant addresses the substantive issue regarding why those rejections should be reversed.

Claims 25 and 27 are patentable over the Tedesco et al. patent

Independent claim 25 recites a vending machine that is operable to prevent acceptance of a monetary unit in dependence on "the availability of monetary units for dispensing as change" and that is operable to inhibit a vend operation depending on various factors including "the availability of monetary units for dispensing change."

The Tedesco et al. patent relates to managing vending machine subscriptions. The vending machine may include mechanisms for receiving payment and dispensing change (col. 4, lines 49-51). However, there is no disclosure whatsoever regarding under what conditions a monetary unit should or should not be accepted.

The process disclosed in the Tedesco et al. patent includes verifying a request to purchase a subscription (col. 7, lines 14-24). Details of the verification are illustrated in FIGS. 8A and 8B. None of those sub-steps relate to inhibiting a vend operation based on the availability of monetary units for dispensing change (*see also* col. 7, line 50-col. 8, line 2).

The Examiner's Answer (at page 8, first par. 4), refers to blocks 820 and 822 of FIG. 8A of the Tedesco et al. patent. Those steps, however, relate to whether the received payment is

sufficient to pay for the identified subscription. They do not relate to the availability of money to be dispensed as change.

Therefore, the fact that the Tedesco et al. patent also discloses a display 124 is irrelevant. There is simply no disclosure or suggestion of a vending machine with a display to provide an indication to a customer "in response to receipt of a monetary unit which is so prevented from being accepted" (*i.e.*, prevented from being accepted in dependence on the availability of monetary units for dispensing as change) as recited in claim 25.

Therefore, the rejections of claim 25 and dependent claim 27 as unpatentable over the Tedesco et al. patent should be reversed.

Claims 25 and 27 are patentable over the Ramsey et al. patent

The Ramsey patent discloses a fuel dispenser 35 which displays sales indicia such as fuel price and fuel quantity units (col. 6, lines 1-5). A video display 57 can provide "additional fueling instructions or other important information about products for sale, or locations of interest to the purchaser." (Col. 6, lines 32-36) That patent also discloses the ability to calculate and dispense change to the purchaser (*see, e.g.*, col. 13, lines 40-41). However, there is no disclosure or suggestion of preventing acceptance of a monetary unit or inhibiting a vend operation in dependence on "the availability of monetary units for dispensing as change" as recited in claim 25.

Therefore, the fact that the Ramsey et al. patent also discloses the ability to display certain information is irrelevant. There is simply no disclosure or suggestion of a vending machine with a display to provide an indication to a customer "in response to receipt of a monetary unit which is so prevented from being accepted" (*i.e.*, prevented from being accepted in dependence on the availability of monetary units for dispensing as change) as recited in claim 25.

Therefore, the rejections of claim 25 and dependent claim 27 as unpatentable over the Ramsey et al. patent also should be reversed.

Other statements in the Examiner's Answer are conclusory and largely irrelevant

The Examiner's Answer, like the prior Office actions, fails to address the specific limitations recited in the appealed claims and fails to provide the type of "clear and particular" motivation to modify the references that is required by the Court of Appeals for the Federal Circuit to support a finding of obviousness under 35 U.S.C. §103. (See Brief on Appeal at pages 5-6) Indeed, the Examiner's Answer tends to lump groups of claims together in a manner that makes it difficult, if not impossible, to understand how the cited references could reasonably be applied to the subject matter of the individual claims. Instead, the Examiner's Answer mostly makes broad statements about the alleged disclosures of the references without explaining how those disclosures relate to the specific limitations of the claims. For example, the Examiner's Answer makes some general comments about the use of displays in the prior art. Those statements are irrelevant in the absence of the required suggestion or motivation to modify the prior art references to obtain the claimed subject matter.

In contrast, applicant's Brief on Appeal (*see, e.g.*, pages 7-15) points to specific features recited in the claims that are not disclosed or suggested by the cited references. The Examiner's Answer does not address those issues in a coherent way.

In the following paragraphs, applicant addresses some of the issues raised in the Examiner's Answer, and in particular in the section of the Examiner's Answer entitled "Response to Argument," starting at the bottom of page 11. However, the absence of a reply by the applicant to a specific issue or comment does not signify agreement with or concession of that issue or comment.

In the section of the Examiner's Answer entitled "Response to Argument" at page 12, lines 7-17, the Examiner relies on U.S. Patent No. 5,987,439 (Gustin et al.).

The Gustin et al. patent, however, did not form the basis of any of the rejections in the final Office action of August 28, 2003, on which this appeal is based. Therefore, that patent is not relevant to the issues raised in this appeal. However, the Examiner's attempt to rely on the

Gustin et al. patent at this late stage is a clear indication that the rejections of the claim should be reversed.

Furthermore, the Gustin et al. patent relates to an automatic banking machine, such as an ATM machine, which allows for dispensing cash, as well as performing other banking functions, such as the payment of bills, wire transfers or cashing checks. The Gustin et al. patent relate to entering amounts of money in an automatic banking machine and displaying the amount of money to a customer (*see, e.g.*, Figures 16 and 17) or to displaying a price of an item to be purchased and an amount of money inserted by a customer. However, that patent does not disclose displaying indications about the sufficiency of available change. The Gustin et al. patent is irrelevant to the appealed claims.

Other statements in the Examiner's Answer are conclusory without any support and whose relevance is questionable. For example, at page 12, lines 17-22, the Examiner's Answer states:

Further regarding Claim 20, note that it would again be expedient for one of ordinarily [sic.] skilled in the art to allow a customer to choose another product based upon the information necessarily required for the process of Morun to work, since it can be envisioned that a customer, instead of paying a certain amount over a particular price for a particular product, might choose another product not requiring an overpay amount.

The fact that some scenario *could be envisioned* where the claimed subject matter might be advantageous is not the test for determining obviousness under 35 U.S.C. §103 and does not provide the required suggestion or motivation for modifying the Morun patent or any of the other cited references so as to obtain the claimed subject matter.

Similarly, the applicant fails to see the relevance of the statement at page 13, lines 1-6 of the Examiner's Answer regarding claim 25. Moreover, such a statement seems to be precisely the type of improper hindsight which the Court of Appeals for the Federal Circuit has warned against. Although the Morun patent considers the lack of change-availability, there is nothing in

Morun to suggest responding to the circumstances set out in claim 25 by providing an indication to a customer on a display. In particular, there is nothing in the Morun patent that suggests informing the customer that his monetary unit was rejected because of lack of change

At page 14 (lines 5-16) and page 15 (lines 5-13), as well as at page 8 (lines 9-14) and page 10 (lines 1-6), the Examiner suggests various interpretations of the phrase “allowable overpay amount” or “overpay amount.” Applicant has addressed that issue in its Brief on Appeal in the paragraph bridging pages 10 and 11 (*see also* page 3, lines 18-20). Applicant’s clear definition and use of the phrase “allowable overpay amount” in the specification, which is consistent with the phrase “overpay amount” as used in the relevant field, should determine the meaning of that phrase as used in the pending claims.

When the phrase “allowable overpay amount” is properly interpreted, it is clear that the cited references do not disclose or suggest the subject matter of the claims that recite that language.

Conclusion

For the foregoing reasons, and the reasons stated in the Appeal Brief, Applicant submits that the final rejections should be reversed.

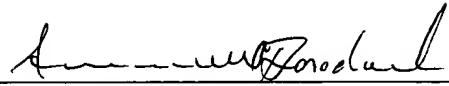
Applicant : Billington et al.
Serial No. : 09/543,164
Filed : April 5, 2000
Page : 7

Attorney's Docket No. 07703-332001

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 8/3/04



Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, New York 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

30198705.doc